IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Kevin MCCARTHY	Confirmation No.: 2223
Application No.: 10/084,982	Examiner: Siegfried E Chencinski
Filed: March 1, 2002	Group Art Unit: 3695

For: METHOD AND COMMUNICATION TERMINAL FOR HANDLING
           PAYMENT OF DOWNLOADABLE CONTENT

Commissioner for Patents
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated July 20, 2009.

I.   REAL PARTY IN INTEREST

NOKIA Corporation is the real party in interest.

II.   RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III.   STATUS OF THE CLAIMS

Claims 1-24 are pending in this appeal. No claim is allowed. This appeal is therefore taken from the final rejection of claims 1-24 on March 19, 2009.

IV.   STATUS OF AMENDMENTS

The amendment to claims 1, 10, and 18 filed July 20, 2009 has been entered.

V.   SUMMARY OF THE CLAIMED SUBJECT MATTER

The claimed invention addresses problems associated with downloading content to a wireless terminal. In particular, the claimed invention permits a user of a wireless terminal an easy way to download content he/she may be interested in purchasing, verify that he/she is satisfied with the downloadable content prior to purchase, and have the verification occur in the environment in which the downloadable content will be employed.

Independent claim 1 provides for the following:

1. A method comprising:

- opening a software application in a wireless terminal (See, e.g., Specification, page 1, lines 15-27, page 6, lines 12-19, Fig. 3),

- requesting downloadable content from the open software application (See, e.g., Specification, page 1, lines 15-27, page 6, lines 12-19, Fig. 3, step 60),

- automatically starting up a network session (See, e.g., Specification, page 1, lines 15-27, page 6, lines 15-19, Fig. 3),

- transmitting in said network session a request for downloading said downloadable content for the software application (See, e.g., Specification, page 1, lines 15-27, page 6, lines 12-26, Fig. 3),

- downloading said downloadable content (See, e.g., Specification, page 1, lines 15-27, page 6, line 20-page 7, line 10, Fig. 3),

- enabling a user of the wireless terminal to pre-study said downloaded content (See, e.g., Specification, page 1, lines 15-27, page 7, lines 6-10, Fig. 3);

- effecting payment for the pre-studied downloaded content for the software application for enabling storing of the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content (See, e.g., Specification, page 1, lines 15-27, page 7, lines 12-19, Fig. 3, step 70), and

- storing of the pre-studied downloaded content for the software application from which the downloaded content for the software application was requested in response to effecting of the payment (See, e.g., Specification, page 1, lines 15-27, page 7, lines 18-19; Fig. 3, step 73).

Independent claim 10 provides for the following:

10. A computer program product comprising at least one computer-readable storage medium having computer-readable program code portions stored therein, the computer-readable program code portions comprising:

- a first executable portion for enabling a user to request downloadable content associated with a software application (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5, step 101),

- a second executable portion for automatically starting up a network session upon detection of a user entered request (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5),

- a third executable portion for transmitting a request in said network session for downloading said downloadable content to a content source (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5, step 101),

- a fourth executable portion for downloading said downloadable content(See, e.g., Specification, page 2, lines 12-24; page 8, lines 7-26; Fig. 5, step 102),

- a fifth executable portion for enabling a user of the wireless terminal to pre-study said downloaded (See, e.g., Specification, page 2, lines 12-24; page 7, lines 6-10; page 8, line 23-page 9, line 10, Fig. 3; Fig. 5, step 108);

- a sixth executable portion for effecting of payment for the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content (See, e.g., Specification, page 2, lines 12-24; page 7, lines 12-19; page 9, lines 5-10; Fig. 3, step 70; Fig. 5, step 107), and

- a seventh executable portion for storing of the pre-studied downloaded content for use with the software application from which the downloaded content was requested in response to effecting of the payment (See, e.g., Specification, page 2, lines 12-24; page 7, lines 18-19; page 9, lines 7-10; Fig. 3, step 73; Fig. 5, step 110).

Independent claim 18 provides for the following:

18. An apparatus comprising a processor (See, e.g., Specification, page 5, lines 6-26, Fig. 2, processor 18) configured to:

open a software application in a wireless terminal (See, e.g., Specification, page 2, lines 12-24; page 8, lines 7-16; Fig. 5, step 100),

request downloadable content from the open software application (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5, step 101),

automatically start up a network session (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5),

transmit in said network session a request for downloading said downloadable content for the software application (See, e.g., Specification, page 2, lines 12-24; page 8, lines 9-11; Fig. 5, step 101),

download said downloadable content (See, e.g., Specification, page 2, lines 12-24; page 8, lines 7-26; Fig. 5, step 102),

enable a user of the wireless terminal to pre-study said downloaded content (See, e.g., Specification, page 2, lines 12-24; page 7, lines 6-10; page 8, line 23-page 9, line 10, Fig. 3; Fig. 5, step 108);

effect payment for the pre-studied downloaded content for the software application for enabling storing of the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content (See, e.g., Specification, page 2, lines 12-24; page 7, lines 12-19; page 9, lines 5-10; Fig. 3, step 70; Fig. 5, step 107), and

store the pre-studied downloaded content for the software application from which the downloaded content for the software application was requested in response to effecting of

the payment (See, e.g., Specification, page 2, lines 12-24; page 7, lines 18-19; page 9, lines 7-10; Fig. 3, step 73; Fig. 5, step 110).

VI.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-24 are obvious under 35 U.S.C. § 103 based on *Wiser et al.* (US 6,868,403) in view of *Sasaki et al.* (US 2002/0077988)?

VII.   ARGUMENT

CLAIMS 1-24 ARE NOT RENDERED OBVIOUS BY *WISER ET AL.* AND *SASAKI ET AL.* BECAUSE NEITHER REFERENCE DISCLOSES OR SUGGESTS A REQUEST FOR, PRE-STUDY OF, AND STORAGE OF, THE SAME DOWNLOADABLE CONTENT, NOR DOES EITHER REFERENCE DISCLOSE OR SUGGEST EFFECTING A PAYMENT ENABLED SUBSEQUENT TO AN ACCOUNT VERIFICATION CONDUCTED RELATIVE TO A USER PRIOR TO THE DOWNLOADING OF THE DOWNLOADABLE CONTENT

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention under any statutory provision always rests upon the Examiner. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed .Cir. 1997); *In re Deuel*, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983). A prior art reference must be considered in its entirety including portions that would lead away from the

claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

The claimed subject matter provides, *inter alia*, for the handling of payment of downloadable content from a content provider to a wireless terminal via a communication network. The handling of such payment includes payment for a pre-study of the downloaded content, which enables storage of the pre-studied downloaded content. In particular, independent claim 1 recites "effecting payment for the pre-studied downloaded content for the software application for enabling storing of the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content." Independent claims 10 and 18 include similar language.

As claimed, the requested content is the **same** content that is pre-studied, which is the **same** content that is downloaded in response to the request, and it is the **same** content that is ultimately stored after payment is effected.

By contrast, the system in *Wiser et al.* displays a web browser page having **a link to a preview** of a desired media data file. As disclosed at col. 15, lines 43-45, of the reference, when the preview link is selected, a request is invoked and a media player eventually receives a stream of the preview, which is then played for the user (See, e.g., col. 16, lines 3-5). The "preview" in *Wiser et al.* is just that, *viz.*, a preview, or a teaser. It is not the content requested or ultimately desired by the user. In fact, the preview video is of much inferior quality and of much more limited duration as compared to the "real," full quality media data (See, e.g., col. 3, lines 60-65). Therefore, in *Wiser et al.*, the "content" that is pre-studied is not the same "content" that will

eventually be downloaded and stored after payment for the content is effected. For example, if one considers the inferior quality preview content to be the content "requested," it is true that the same content that is requested is that which is pre-studied. But, in that case, the inferior quality content that is requested and pre-studied, unlike the instant claimed subject matter, is **not** the same content that is actually downloaded and stored upon payment for the content. That is, in *Wiser et al.*, the purchased content will be the superior, full quality, version of the content pre-studied; it will not be the inferior quality, pre-studied content. On the other hand, if one considers the requested content to be the full quality version of the content in *Wiser et al.*, then the pre-studied content is clearly of a much more inferior quality, different from the content requested and different from the content ultimately stored if and when the content is purchased.

However, the instant claimed subject matter recites that the content that is requested, pre-studied and ultimately stored if purchased, to be the **same content**. It is noted, again, that the language of claim 1, for example, states: "effecting payment for **the pre-studied downloaded content** for the software application for enabling **storing of the pre-studied downloaded content** for the software application without further user interaction beyond **selecting the pre-studied downloaded content for storage**, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content." The pre-studied and stored content is the **same content** that was originally requested, i.e., "**requesting downloadable content** from the open software application."

This is not merely a distinction without a difference. The request for, download of, pre-study of, and ultimate storage of, if purchased, of the **same content**, as claimed, offers novel and unobvious advantages over the prior art. Thus, a user is able to listen to a full, or actual, version of the content that user may wish to purchase. That is, the user is able to listen to the content in

its actual, full quality form. This may render the content more attractive to the user/prospective purchaser. Moreover, only one network connection is required to be established in order to purchase content in accordance with the instant claimed subject matter. That is, only one session is required between the server and the downloading device since what the user sees is what the user gets. This feature offers more reliability and uses less bandwidth when contrasted to the system of *Wiser et al.*, where a user may be unable to download the full quality content once the user decides to do so since the network connection may be lost during the pre-study phase of the operation. This risk is avoided by the claimed subject matter because only a single session is required and once the decision to purchase is made, and the session is completed, all necessary data is present on the device.

Appellant recognizes that the rejection of the claims is based not on *Wiser et al.*, alone, but rather on the combination of *Wiser et al.* and *Sasaki et al.* However, *Sasaki et al.*, employed for an alleged teaching of a wireless terminal and opening a software application in a wireless terminal, does not provide for the deficiencies of *Wiser et al.*, explained above.

With regard to the Examiner's assertion, at page 3 of the Final Office Action, that "it is obvious in **Sasaki** that a pre-study enables a user to receive downloadable content in full quality and full length," *Sasaki et al.* actually teaches away from the instant claimed invention. A reference may be said to "teach away" when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference or would be led in a direction divergent from the path that was taken by the applicant. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). In *Sasaki et al.*, in accordance with paragraphs [0033] and [0034], a user may simply copy content from one device to another without any payment at all. For example, the last two lines of paragraph [0033] recite "In other embodiments,

unlicensed users 26 may transmit digital content to other users." Enabling such unauthorized copying by a user who has not paid for the privilege is directly contrary to the teachings of the instant claims enabling downloading and pre-study, but only enabling saving of the content responsive to purchasing the content.

Moreover, because *Sasaki et al.* requires meta-data to be attached to the content as an indication of whether a user is licensed (See, e.g., paragraph [0033]), special equipment is necessary in order to read and understand the attached meta-data. Therefore, only pre-processed content, i.e., content that has the meta-data previously attached, may be employed with the system of *Sasaki et al.* This, clearly, is a disadvantage of the *Sasaki et al.* system and would have discouraged those skilled in the art from combining *Sasaki et al.* with *Wiser et al.*, which does not suffer from such a disadvantage. Accordingly, facing the dissimilarities of the *Wiser et al.* and *Sasaki et al.* systems and the limited use of the *Sasaki et al.* system requiring special equipment to read/understand the meta-data attached to the content, the skilled artisans would only have sought to combine them through impermissible hindsight gleaned from a knowledge of Appellant's disclosure.

Finally, the subject matter of the claims on appeal provide for the details of payment to be agreed upon **prior to the downloading and/or purchase of the content.** For example, claim 1 recites "effecting payment for the pre-studied downloaded content for the software application for enabling storing of the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein **effecting the payment is enabled <u>subsequent to an account verification</u> conducted relative to the user <u>prior to the downloading</u> of said downloaded content.**" Contrary to this claim feature, *Wiser et al.* does not confirm account status until after preview content is requested and

delivered (See, e.g., Figs 8 and 9a). *Sasaki et al.* is completely devoid of any such feature. Therefore, neither *Wiser et al.* nor *Sasaki et al.*, taken alone or in combination, discloses or suggests "wherein **effecting the payment is enabled <u>subsequent to an account verification conducted relative to the user <u>prior to the downloading</u> of said downloaded content</u>.**"

For all of the reasons above, the combination of *Wiser et al.* and *Sasaki et al.* fails to establish a *prima facie* case of obviousness with regard to the subject matter of the claims on appeal, within the meaning of 35 U.S.C. § 103.

VIII.   <u>CONCLUSION AND PRAYER FOR RELIEF</u>

For the foregoing reasons, Appellant requests the Honorable Board to reverse the Examiner's rejection.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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IX. <u>CLAIMS APPENDIX</u>

1. A method comprising:

- opening a software application in a wireless terminal,

- requesting downloadable content from the open software application,

- automatically starting up a network session,

- transmitting in said network session a request for downloading said downloadable content for the software application,

- downloading said downloadable content,

- enabling a user of the wireless terminal to pre-study said downloaded content;

- effecting payment for the pre-studied downloaded content for the software application for enabling storing of the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content, and

- storing of the pre-studied downloaded content for the software application from which the downloaded content for the software application was requested in response to effecting of the payment.

2. A method according to claim 1, wherein the requested downloadable content includes at least one of the following items:

- a ring tune,

- a tactile feed back from a vibrator,

- a graphic icon,

- an animation, and

- a new maze or background for a game.

3. A method according to claim 1, wherein the networks session is a WAP session.

4. A method according to claim 3, wherein the WAP session is established with a pre-identified content provider.

5. A method according to claim 4, wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloadable content includes transfer of an amount from said account to the content provider upon approval by the user.

6. A method according to claim 5, wherein the storing of said downloaded content is enabled once the user has approved said payment.

7. A method according to claim 3, wherein the WAP session is established with a pre-identified Internet portal hosting at least one content provider.

8. A method according to claim 7, wherein the user of the wireless terminal has an account at the pre-identified Internet portal, and wherein the handling of payment for said downloaded content includes transfer of an amount from said account to the content provider upon approval by the user.

9. A method according to claim 8, wherein the storing of said downloaded content is enabled once the user has approved said payment.

10. A computer program product comprising at least one computer-readable storage medium having computer-readable program code portions stored therein, the computer-readable program code portions comprising:

- a first executable portion for enabling a user to request downloadable content associated with a software application,

- a second executable portion for automatically starting up a network session upon detection of a user entered request,

- a third executable portion for transmitting a request in said network session for downloading said downloadable content to a content source,

- a fourth executable portion for downloading said downloadable content,

- a fifth executable portion for enabling a user of the wireless terminal to pre-study said downloaded;

- a sixth executable portion for effecting of payment for the pre-studied downloaded content for the software application without further user interaction beyond selecting the pre-studied downloaded content for storage, wherein effecting the payment is enabled subsequent to an account verification conducted relative to the user prior to the downloading of said downloaded content, and

- a seventh executable portion for storing of the pre-studied downloaded content for use with the software application from which the downloaded content was requested in response to effecting of the payment.

11. A computer program product according to claim 10, wherein the requested downloadable content includes at least one of the following items:

- a ring tune,

- a tactile feed back from a vibrator,

- a graphic icon,

- an animation, and

- a new maze or background for a game.

12. A computer program product according to claim 10, wherein the networks session is a WAP session.

13. A computer program product according to claim 12, wherein the WAP session is established with a pre-identified content provider.

14. A computer program product according to claim 10, further comprising an eighth executable portion for discarding the pre-studied downloaded dewnleadable content if the user does not select to store the pre-studied downloaded devalleadable content.

15. A method according to claim 1, further comprising discarding the pre-studied downloaded content if the user does not select to store the pre-studied downloaded content.

16. A computer program product according to claim 10, wherein the second executable portion includes instructions for providing a plurality of available downloadable items for selection based on a status of an account of the user.

17. A method according to claim 1, wherein automatically starting up the network session further comprises providing a plurality of available downloadable items for selection based on a status of an account of the user.

18. An apparatus comprising a processor configured to:

open a software application in a wireless terminal,

request downloadable content from the open software application,

automatically start up a network session,

transmit in said network session a request for downloading said downloadable content for the

software application,

download said downloadable content,

enable a user of the wireless terminal to pre-study said downloaded content;

effect payment for the pre-studied downloaded content for the software application for

enabling storing of the pre-studied downloaded content for the software application

without further user interaction beyond selecting the pre-studied downloaded content for

storage, wherein effecting the payment is enabled subsequent to an account verification

conducted relative to the user prior to the downloading of said downloaded content, and

store the pre-studied downloaded content for the software application from which the

downloaded content for the software application was requested in response to effecting of

the payment.

19. An apparatus according to claim 18, wherein the processor is configured to request

downloadable content including at least one of the following items:

- a ring tune,

- a tactile feed back from a vibrator,

- a graphic icon,

- an animation, and

- a new maze or background for a game.

20. An apparatus according to claim 18, wherein the network session is a WAP session.

21. An apparatus according to claim 20, wherein the WAP session is established with a pre-identified content provider.

22. An apparatus according to claim 21, wherein the user of the wireless terminal has an account at the pre-identified content provider, and wherein the handling of payment for said downloaded content includes transfer of an amount from said account to the content provider upon approval by the user.

23. An apparatus according to claim 22, wherein the storing of said downloaded content is enabled once the user has approved said payment.

24. A method according to claim 1, wherein the handling of the payment is based on a pre-existing agreement associated with the wireless terminal directly with an account.

X.   <u>EVIDENCE APPENDIX</u>

Appellant is unaware of any evidence that is required to be submitted in the present Evidence Appendix.

XI.   <u>RELATED PROCEEDINGS APPENDIX</u>

Appellant is unaware of any related proceedings that are required to be submitted in the present Related Proceedings Appendix.